

REMARKS

Applicant has carefully studied the Final Office Action of March 9, 2004 and offers the following remarks to accompany the above amendments.

Initially, Applicant amends claims 1 and 17 to recite that the information is sent to a plurality of devices. Support for this can be found at paragraph 41. No new matter is added.

Claims 1-7 and 11-23 were rejected under 35 U.S.C. § 103 as being unpatentable over Amin et al. (hereinafter "Amin") in view of Tsoukas et al. (Hereinafter "Tsoukas"). Applicant respectfully traverses. Before the Patent Office can assert *prima facie* obviousness based on a combination of references, the Patent Office must properly combine the references. To combine the references, the Patent Office must indicate 1) a motivation to combine the references and 2) provide actual evidence that the motivation to combine comes from a proper source. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Further, the Patent Office is not free to ignore portions of the references being combined. Specifically, if a portion of the reference teaches away from the combination, that is evidence of non-obviousness. MPEP § 2143.01. Likewise, if a combination renders a reference unsuitable for its intended purpose, then this is further evidence of non-obviousness. *Id.* Once the combination is properly made, the combination must still show each and every claim element to establish *prima facie* obviousness. MPEP § 2143.03.

Applicant initially addresses the combination applied to claims 1-7 and 11-23. These arguments apply to all the claims. The Patent Office proposes the combination of Amin and Tsoukas to reject this claim. While the Patent Office does indicate that it would have been obvious to modify Amin so that a user may receive any desired information based on time or predetermined times, location, and event triggers that outline when certain types of information are to be delivered (see page 13, lines 15-17), the Patent Office provides no actual evidence to support this motivation. Since there is no actual evidence, the Patent Office has not complied with the mandate of the Federal Circuit, and the combination of references is improper. Since the combination of references is improper, the references stand individually. The Patent Office admits that Amin does not teach or suggest all the claim elements, so Amin individually does not establish obviousness. The Patent Office has not articulated how Tsoukas teaches or suggests all the elements, and absent such an explanation, Tsoukas individually cannot establish obviousness. To this extent, Applicant respectfully requests withdrawal of the § 103 rejection of claims 1-7 and 11-23 at this time.

Further, even if the Patent Office had supported the motivation to combine the references (a point which Applicant does not concede), the Patent Office is ignoring the portion of Amin which indicates that it is designed to be a push model. Specifically, col. 1, line 45-col. 2, line 20 of Amin indicate that the stores or vendors are pushing content to the user, regardless of the user's wishes. Such an approach teaches away from a system that allows a user to select when they receive content. In short, Amin teaches away from the combination. Since Amin teaches away from the combination, the combination is improper and the references must be considered individually. As explained above, the references individually do not establish obviousness and claims 1-7 and 11-23 are allowable.

Even if the Amin does not explicitly teach away from the combination, Amin no longer works as intended if the combination is implemented. Specifically, by allowing customers to create their own profiles and dictate the terms and conditions under which content is received, the stores and vendors of Amin are no longer able to push unwanted content to the customers. Since Amin presupposes the ability to push this unwanted content to the customers, removing this feature means that Amin no longer works as intended. As explained above, causing a reference to no longer work in the intended fashion is evidence of non-obviousness. The combination of record does not establish obviousness for claims 1-7 and 11-23 for this reason as well.

Independent claims 1 and 17 have been amended to recite that the information is sent to a plurality of communication devices. Applicant has studied the references and finds no teaching or suggestion of this element. The references individually, and in combination, teach that the notification is sent to a single device. If the Patent Office disagrees, the Patent Office is invited to identify where in the references this element is taught or suggested. Absent such a teaching, the combination does not teach or suggest all the claim elements, and the combination does not establish obviousness for the independent claims 1 and 17. Since the combination does not establish obviousness for the independent claims, the dependent claims are likewise not rendered obvious. Applicant requests withdrawal of the § 103 rejection of claims 1-7 and 11-22 at this time in light of the amendment.

Claims 8-10 were rejected under 35 U.S.C. § 103 as being unpatentable over Amin in view of Tsoukas and further in view of Asaoka et al. (hereinafter "Asaoka"). Applicant respectfully traverses. The standard for establishing obviousness is set forth above.

Applicant initially notes that the Patent Office does nothing to cure the problems with the combination of Amin and Tsoukas. Since this combination remains improper, the rejection fails and the claims are allowable. Applicant further notes that while the Patent Office indicates that the reason to combine Asaoka is "notifying weather updates to a visitor/traveler for preparing or making a decision to go over there or not," this is not supported with any actual evidence as mandated by the Federal Circuit. Since this additional combination is not properly supported, there is an independent reason why these claims are not properly rejected.

Still further, claims 8-10 depend from claim 1 and thus include the elements of claim 1. Nothing in Asaoka cures the deficiencies of the underlying combination of Amin and Tsoukas. Since the combination of references does not teach or suggest the plurality of notifications to a plurality of devices, the combination of references does not establish obviousness. For these reasons, Applicant requests withdrawal of the § 103 rejection of claims 8-10 at this time.

Applicant requests reconsideration of the rejection in light of the amendments and arguments presented herein. The combinations advanced by the Patent Office are improper and, even if they were proper, do not teach or suggest all the claim elements. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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Date: MAY 7, 2004  
Attorney Docket: 7000-078